REMARKS/ARGUMENTS

A. AMENDMENTS TO THE CLAIMS

Claims 1-20 remain in this application. Claims 1, 13-14, and 20 have been amended.

B. ANTICIPATION CLAIM REJECTIONS

Claims 1-12 have been rejected by the examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,108,656 issued to *Durst* et al. (herein, *Durst*).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

1. Independent Claim 1

Claim 1 (as currently amended) recites the following limitations:

> 1. A method for the creation of an electronic container to conduct a business transaction comprising:
> creating an electronic version of an object useful in conducting the business transaction;
> creating a graphical code representing information about the object; associating the graphical code with the object;
> assigning a transaction identifier to the object to associate the object with the business transaction; and
> storing the object with other objects having the same transaction identifier.

In rejecting claim 1, the examiner cited **Figure 1** and the written description of *Durst* relating thereto as disclosing each of these limitations. **Figure 1** of *Durst* illustrates three components of a document access system: document generation (14), a client computer (32), and a target server computer (46). A document (10) comprising a barcode (12) and, optionally, text and graphics (16, 18) is created by a printer. The barcode (12) includes a data string (20) that is read by a barcode scanner (34) component of the client computer (32). The data string (20) is used to retrieve a file from local memory (94), a LAN (98) or an Internet server (48).

The examiner equated the electronic version of the text (16) with the object of claim 1

and the barcode (12) as representing information about the object (16). However, as will be discussed below, this interpretation of *Durst* is not consistent with meaning assigned to those terms by the present application.

When applying a reference to the pending claims of an application, the pending claims must be "given their broadest reasonable interpretation consistent with the specification" *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). In *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), the court held that the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). See, MPEP §2111 (8th Ed., Rev. 1). Applicant submits if the pending claims of the present application are examined with full appreciation of the meaning ascribed to the terms used in the claims by the written description (and not the meaning given to those terms by *Durst*), it will become clear that *Durst* does not teach the limitations of the pending claims. In particular, it is important in applying *Durst* to the present invention to clearly distinguish between the object and the information that relates to the object.

According to the Abstract section of *Durst*, the invention taught by *Durst* is directed to file retrieval:

> The present invention is a system and method for providing automated access to electronic information stored in a database in either a local or remote location. The system utilizes a machine-readable code printed on a document, referred to herein as an intelligent document since it stores information used to automatically access the information. The machine-readable symbol comprises encoded source data, wherein the source data comprises application launch information as well as file location information. *Durst*, Abstract.

By contrast, the present invention is directed to a "delivery object":

> Accordingly, there is a need in industry for a means to permit paper documents to be converted into electronic format while also retaining the relevant index data information.

> Further, this electronic format must act as a standardized "container" for delivering information, such as documents, data and images via email, the Internet, on disk, or on CD, or in any other electronic form. The standardized container must also be able to reproduce a copy of the original document that was converted. This standardized container must be able to easily adapt to a changing business environment where the source of the initial content may predominantly be paper documents to where as the industry shifts to more electronic content will still provide similar benefits. **The container must also provide information about its contents known as "meta-data."** This meta-data must be provided in a specific and consistent manner that facilitates the development of browser applications as well as automation. Therefore, the container must support any spectrum of content and present it to a user or system in a consistent fashion to promotes its use and automation. Further a system using this container would need to include delivery methods for supplying both customers and business partners with instant information that is needed. In other words, a delivery object that supports both ad hoc support requests for information as well as large volume transactions is needed. Specification, page 3, lines 3-19. Emphasis added by bolding.

In the hierarchy of the present invention, the container comprises objects and a graphical code representing information about the objects. *Durst* describes a barcode that is printed on a "document" along with text or graphics. While the text or graphics is physically associated with the barcode, the content of the barcode does **not** represent information about the text or graphics. The barcode is not, therefore, a graphical code representing information about the object.

The Detailed Description section of *Durst* further explains the operation of the disclosed document access system:

> The system operates with respect to FIGS. 1 and 6 as follows. A vendor who wishes to provide an intelligent document 10 programs certain parameters which will be encoded within a machine-readable code 12 and printed on the document along with text 16 or graphics 18. The document may be an advertisement in the form of a magazine insert or page, a brochure, a label for an envelope, a memorandum, and the like. Parameters to be included within the machine-readable code depend upon the application desired by the vendor. For example, if the vendor wants the end-user to be able to load the vendor's world wide web (WWW) site automatically upon scanning the code 12, then the parameters included in the data string 20 that is assembled into the machine-readable code include a command 22 to launch an Internet browser application, such as NETSCAPE, and a file location pointer such as a uniform resource location (URL) code, such as www.xyzcorp.com (see FIG. 2). This information is encoded with encoding function 20 in accordance with the particular type of machine code being used. For example, one type of code which may be used by the present invention is a PDF417 symbol, which is described in detail in U.S. Pat. No. 5,304,786, which is incorporated by reference herein. The PDF417 symbol, known as a two-dimensional bar code symbol, has

> enough storage information to encode the browser launch command as well as the URL. A printer 30 then utilizes the encoded data and desired text 16 and graphics 18 to print an intelligent document 10 a shown in the Figures. *Durst*, Col.4, line 53 to Col. 5, line 14.

While *Durst* associates a file with a barcode, *Durst* does not teach or disclose the limitations of creating an electronic version of an object, assigning a transaction identifier to the object; and storing the object with other objects having the same transaction identifier as noted in claim 1 of the Application.

The "object" referred to in the limitation of claim 1 of the Application is associated with a graphical code that represents information about the object that was created. By contrast, *Durst* uses the barcode (graphical code) to retrieve a file stored elsewhere, not to convey information about an object. Applicant submits that the barcode is not, therefore, a graphical code representing information about the object

The examiner constructed a "transaction identifier" from the following conditional statement in *Durst*: "...if the vendor wants the end-user to be able to load the vendor's world wide web (WWW) site automatically upon scanning the code 12, then the parameters included in the data string 20 that is assembled into the machine-readable code include a command 22 to launch an Internet browser application..." *Durst*, Col. 4, lines 65-67. According to this logic, loading the vendor's World Wide Web (WWW) site is a transaction and the website "WWW" is an "identifier" of a transaction, and, hence, a "transaction identifier."

A reasonable interpretation of the *Durst* disclosure does not support the conclusion that the loading of a Web Site address is a "transaction" and a Web Site address is a "transaction identifier" as those terms are used in claim 1 of the present invention. As stated in the written description of the Application:

> In environments where electronic files are used, there are still difficulties encountered by businesses trying to implement such files to **transact business**. As in many cases, a collection of **different types of electronic files will comprise the transaction**. Specification, page 2, lines 17-19. Emphasis added by bolding.

In order clarify the meaning of "transaction" as used in claim 1 of the present invention clear, Applicant has amended claim 1 to recite a method directed to the creation of an electronic

container to "conduct a business transaction." An electronic version of the object "useful in conducting the business transaction" is created and a transaction identifier is assigned to the object to associate the object "with the business transaction."

Durst also fails to teach or disclose the limitation "storing the object with other objects having the same transaction identifier" as recited by claim 1 of the present invention. The examiner identified the object stored with the same transaction identifier as the demographics information of users, which information is stored in demographics log 52 (citing *Durst*, Col. 5, lines 62-67). The demographic information of a user disclosed *Durst* is not an "object" as taught by claim 1 of the present invention but is component of the symbol data string 20 incorporated into the barcode (12). (See **Figure 2**; Abstract, "Additional user-specific demographic data such as the user's name and address may also be encoded in the machine-readable code...") The demographic information is created by the Web site operator and is not available to the recipient of the document to which the barcode relates: "This demographic information is uploaded to the WWW site for use by the vendor." *Durst*, Col. 2, lines 36-37.

Claim 1, both as originally claimed and in its amended form, recites limitations not in *Durst*. For this reason, *Durst* does not anticipate claim 1. Applicant submits that claim 1 is allowable over the cited prior art.

2. **Dependent Claims 2-6**

Dependent claims 2-6 depend from claim 1 and comprise all of the limitations of claim 1. As claim 1 recites limitations not disclosed in *Durst*, dependent claims 2-6 are not anticipated by *Durst*.

Claim 4 of the present invention depends from claim 1 and recites the additional limitation, "wherein the graphical code comprises routing information." With respect to claim 4, the examiner pointed to the following disclosure of *Durst* as teaching the limitation that the graphical code comprises routing information:

> For example, if the vendor wants the end-user to be able to load the vendor's world wide web (WWW) site automatically upon scanning the code 12, then the parameters included in the data string 20 that is assembled into the machine-readable code include a command 22 to launch an Internet browser application, such as NETSCAPE, and a file location pointer such as a uniform resource location (URL) code, such as www.xyzcorp.com (see

FIG. 2). *Durst*, Col. 4, line 62 through Col. 5, line 3.

The "location pointer" is not used for routing, but for retrieval (pulling) of a file. The file location pointer is not, therefore, "routing information" as that phrase is used in the application:

> Routing information concerning where the document should go at various steps within the workflow of the organization and for example, where the document should be delivered upon return, can also all be contained within the unique barcode of the present invention. Application, page 38, lines 17-20.

The file location pointer identified by *Durst* is directed to finding a file on a server. Neither the machine readable code nor the file location pointer described by *Durst* identifies means to redirect documents associated with a container to different locations for processing and reassembling those documents when processing is completed. *Durst* does not disclose or teach "routing" as that term in used in claim 4. See, MPEP §2111 (8th Ed., Rev. 1) and previous discussion relating to that section.

Claim 6 of the present invention depends from claim 1 and recites the method of claim 1 as "further comprising binding the object to other objects wherein the graphical code comprises binding information that relates the one object and each of the other objects to each other." With respect to claim 6, the examiner referred to **Figure 1** as support for construing the text (16) added to a barcode (12) as an object. The examiner then referred to **Figure 2** and construed the file location pointer (21) as "the file location of the at least 1 object 16." Paper #7, page 3. However, as previously discussed, the text (16) does not constitute an "object" within the meaning of claim 1 of the present invention. Rather the barcode (12), with or without text (16) provide a means to access a file. The file locator pointer does not identify the location of the text (16) but a file located in local memory (94) on a client computer (32), on a LAN (98), or a target server computer (46). See, **Figure 1**.

The examiner also construed **Figure 2** as illustrating "other objects (22-26)." Paper #7, page 4. However, call outs 22-26 of **Figure 2** illustrate elements of the symbol string data (20) that comprises the barcode (12). Thus, these string elements are not "objects" as that term is used in claim 1 of the present invention. *Durst* describes and teaches associating a barcode (12) with a single file identified by a singular file pointer identifier (21) included in a symbol data

string (20). *Durst* offers no mechanism for relating discrete objects to each other. By contrast, the application discloses a system and method for binding an object to any number of objects via a graphical code that comprises binding information:

> It is yet another objective of the present invention to include within the machine-readable symbol, information that may be specific to group a set of related documents together. For example, the individual pages of a multi-page document, and related form sets, such as and not limited to mortgage, health care and legal documents. For example in the case of a mortgage document, a note, deed of trust, title policy amongst others may be related through common information shared in the machine readable symbol that is associated with each document within the set of documents.
>
> Application, page 10, lines 4-10.

The additional limitations of Claim 6 are not, therefore, disclosed by *Durst*.

In view of the above arguments, Applicant respectfully submits that claims 2-6 are novel and not anticipated by the cited prior art.

3. **Independent Claim 7**

Claim 7, as amended, recites the following limitations:

> A system for the creation of an electronic container to conduct a business transaction comprising:
>
> an object containing information useful in conducting the business transaction;
>
> a workstation for inputting data about the object;
>
> a graphical code creator connected to the workstation for crating a graphical code comprising the data;
>
> an electronic record creator connected to the scanner for creating a composite electronic record comprising the object and the graphical code; and
>
> a container creator for associating the object with other objects and for assigning a transaction identifier to the object.

Original claim 7 was also rejected under 35 U.S.C. §102(e) as being anticipated by *Durst*. For the reason previously stated with respect to claim 1, *Durst* does not teach or disclose the limitations of an electronic record creator connected to the scanner for creating a composite electronic record comprising an object and a container creator for associating the object with other objects and for assigning a transaction identifier to the object. Applicant submits that *Durst* does not disclose or teach creating an object, assigning a transaction number to the object,

or associating objects with each other. As with claim 1, Applicant has amended claim 7 to make the meaning of the term "transaction" as used in claim 7 clear.

Claim 7, as amended, recites the limitation "a workstation for inputting data about the object." According to the examiner, text (16) and graphics (18) illustrated in **Figure 1** comprise an object, the Document Generation (14) element comprises a workstation for inputting data about the object. However, the data string (20) does not include information about the text (16) or graphic (18). Rather, data string (20) comprise information for accessing a file located file in local memory (94) on a client computer (32), on a LAN (98), or a target server computer (46). See, **Figure 1**. Thus, *Durst* does not teach or disclose a workstation for inputting data about the object.

Claim 7 also recites the limitation "an electronic record creator connected to the scanner for creating a composite electronic record comprising the object and the graphical code." While *Durst* discloses "an intelligent document (10)" comprising a printed barcode (12) with optional text (16) and graphics (18), the intelligent document does not comprise an object as that term is used in claim 7 of the present invention. Rather the intelligent document "stores information used to automatically access ... information. *Durst*, Abstract. Thus, *Durst* does not teach or disclose the limitation of "creating a composite electronic record comprising the object and the graphical code."

Claim 7 of the present invention discloses the limitation "a container creator for associating the object with other objects and for assigning a transaction identifier to the object." The examiner equated the data string (20) as a container, text (16) and graphics (18) as the object, and the elements of data string (22-26) as other objects. However, this construction is contradictory in that the data string (20) is a constituent of barcode (12), which was previously equated to the graphical code of the instant claim. The data string cannot be the container and the information about the container simultaneously. The data string elements (22-26) cannot also be other objects as they represent information, not things for which information is being conveyed.

As previously noted, text (16) and graphics (18) do not collectively or individually constitute an object as that term is used in claim 7. Data string elements (22-26) are also not

objects. Data string (20) is not a container within the lexicon of the present invention, but the content of a barcode that conveys information for retrieving a file. Claim 7, both as originally claimed and in its amended form, recites limitations not in *Durst*. For this reason, *Durst* does not anticipate claim 7.

4. **Dependent Claims 8-12**

Dependent claims 8-12 depend from claim 7 and comprise all of the limitations of claim 7 (as amended). As claim 7 recites limitations not disclosed in *Durst*, dependent claims 8-12 are not anticipated by *Durst*. Additionally, to the extent the examiner's arguments with respect to claim 8-12 are based on the finding that text (16) and graphics (18) constitute an object, Applicant reiterates its previously arguments with respect to that finding.

5. **Independent Claim 13**

Claim 13, as amended, currently recites the following limitations:

A method for managing workflow within an organization comprising:

receiving an electronic container comprising an object associated with a business transaction and routing information associated with the object;

routing the object to a recipient designated in the routing information for processing the business transaction; and

receiving from the designated recipient a processed object.

The examiner found that *Durst* disclosed a method for managing workflow within an organization:

> The system 10 of the present invention has additional embodiments which allow quick and easy retrieval of a data file on a local basis as well as the Internet 44. That is, the same principles may be applied within a company utilizing an intranet or local area network (LAN) 98. Thus, a department of a company may distribute fliers regarding certain events, new products, etc., and encode appropriate document access information in accordance with the teachings of the invention. The user may obtain further information by scanning the code on the document, which then causes his computer to access his network, file server, etc.
>
> This embodiment is also useful in a small office environment, where a user prints out documents such as letters or memos that may need to be revised at a later date. It is common practice to manually type in the drive location of the document in the lower corner of the document to allow the user to easily access the document at a later date, without searching through massive amounts of files. *Durst*, Col. 6, lines 23-40.

This excerpt from *Durst* at most teaches that a barcode can be used to retrieve a file within a company or a small business. There is no suggestion in this language of a "flow" of work. Rather, both examples simply refer to "access" by a user. By contrast, the present invention teaches a broad concept of "workflow:"

> It is a further objective of the present invention to allow workflow or other characteristics to be encapsulated within the package. This is such as and not limited to, embedded applications, or code that may be run within the package to provide workflow or other data or file manipulation, rules enforcement, and delivery options based on rules executed within the package. Specification, page 13, lines 1-5.

Referring to **Figure 3**, the examiner further cited text and the image of a car [10] as a "container" comprising objects associated with barcode 12, that is, routing information. (Previously, in rejecting claim 7, the examiner found that the data string (20) was a container and text (16) and graphics (18) were objects.)

The text, graphics, and barcode combination depicted in **Figure 3** is not the "container" of the present invention. To reiterate, *Durst* describes an "intelligent document" comprising a bar code and, optionally, text and/or graphics. The bar code allows a user to retrieve a file. The optional text and/or graphics allow the holder of the file to present instructions, advertising, or other information to the recipient of the "intelligent document." The optional text and graphics are not described by the bar code and are not "objects" and the barcode is not a container comprising objects as that term is used in the present invention:

> The second component of the system is a standardized electronic container Virtual Package ("Virpack"), which is an electronic file that may be used to store any type of object such as an image, document, database, or any computer generated file including word processing, database, EDI or any other type of file. It may also be construed to be a stand-alone workflow envelope or container. An important feature of a VirPack is that documents stored within the VirPack are retained in the original format in which they are created. Therefore, the recipient of a VirPack can manipulate an object contained within a VirPack using the same application (such as MS-Word) that the sender used to create the object. If the user so desires, applications may however, be created to convert documents into other formats such as converting a MS-Word document into an Adobe Acrobat (PDF file) prior to the document being added to the VirPack. Further, specific (unlimited) index information may be created and stored that is specifically associated with a particular object. Specification, page 19, line 11 through page 20, line 2.

As depicted in **Figure 3** of *Durst*, the text, graphic, and barcode combination (10) is not

"an electronic file that may be used to store any type of object."

The examiner determined that *Durst* also disclosed routing information:

> Parameters to be included within the machine-readable code depend upon the application desired by the vendor. For example, if the vendor wants the end-user to be able to load the vendor's world wide web (WWW) site automatically upon scanning the code 12, then the parameters included in the data string 20 that is assembled into the machine-readable code include a command 22 to launch an Internet browser application, such as NETSCAPE, and a file location pointer such as a uniform resource location (URL) code, such as www.xyzcorp.com (see FIG. 2). This information is encoded with encoding function 20 in accordance with the particular type of machine code being used. *Durst*, Col.4, line 61 through Col. 5, line 5.

The "location pointer" is not used for routing, but for retrieval (pulling) of a file. The file location pointer is not "routing information" as that phrase is used in the application:

> Routing information concerning where the document should go at various steps within the workflow of the organization and for example, where the document should be delivered upon return, can also all be contained within the unique barcode of the present invention. Application, page 38, lines 17-20.

The file location pointer identified by *Durst* is directed to finding a file on a server. The Neither the machine readable code nor the file location pointer described by *Durst* identifies means to redirect documents associated with a container to different locations for processing and reassembling those documents when processing is completed. Retrieving a file and displaying it on a computer is not processing a file *Durst* does not disclose or teach "routing."

In order to make the meaning of claim 13 clear, Applicant has amended claim 13 to recite receiving an electronic container comprising an object associated with a "business transaction" and routing the object to a recipient designated in the routing information for processing the business transaction.

6. **Dependent Claims 14-20**

Dependent claims 14-20 depend from claim 13 and comprise all of the limitations of claim 13. As claim 1 recites limitations not disclosed in *Durst*, dependent claims 14-20 are not anticipated by *Durst*.

Claim 18 recites the further limitation "receiving a graphical code indicative of an

organizational structure of the electronic container." Claims 19 and 20 depend from claim 18. The examiner, cited the following excerpt from *Durst* to support the conclusion that *Durst* described receiving a graphical code "indicative of an organization structure of the electronic container:"

> Parameters to be included within the machine-readable code depend upon the application desired by the vendor. For example, if the vendor wants the end-user to be able to load the vendor's world wide web (WWW) site automatically upon scanning the code 12, then the parameters included in the data string 20 that is assembled into the machine-readable code include a command 22 to launch an Internet browser application, such as NETSCAPE, and a file location pointer such as a uniform resource location (URL) code, such as www.xyzcorp.com (see FIG. 2). This information is encoded with encoding function 20 in accordance with the particular type of machine code being used. *Durst*, Col. 4, line 61 through Col.5 line 5.

While the cited text describes the content of the barcode 12 and the components of data string 20, there is nothing in this text that describes the "structure" of the container itself. By contrast, the present invention is clear in this regard:

> It is a further objective of the present invention to provide standard structures for use between businesses or end users, such as a template, that allows a particular package to have the same characteristics for use with in a similar purpose or industry. Specification, page 12, lines 21-23.

Not only does *Durst* not disclose information regarding the structure of a container, *Durst* does not teach or describe a means for identifying the order of objects within a container (Claim 19) and means for determining whether a container is comprises all of the objects associated with a business transaction.

C. OBVIOUSNESS OBJECTIONS

Claim17 of the present invention has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Durst* as applied to claim 16 and further in view of U.S. Patent 6,215,992 issued to *Howell* (herein, "*Howell*").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

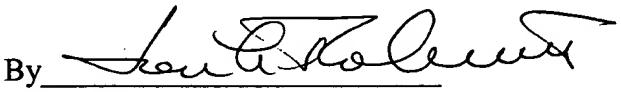
combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP. §2142 (8th Ed , Rev. 1). The references and the applicant's disclosure must be considered as a whole. MPEP §2142.02 (8th Ed., Rev. 1).

Claim 17, which depends from independent claim 13 through dependent claim 16, recites the limitation "wherein object index information comprises information indicative of a field value, a field name, a field type, and a length value." The examiner, citing **Figure 2**, found that *Durst* disclosed a field value, a field type, and a checksum. However, the field labels and values depicted in **Figure 2** of *Durst* are not index information relating to an object. Rather, the field format in *Durst* is structured so as to inform the encryption processing of the obfuscating function (60) where to find the data (fields 1-3) and where to find the encryption data (fields 4-6). These field labels and values do not provide index information related to an object as described in the present invention. For these reason, Applicant submits that claim 17 is not obvious in light of *Durst* in further in view of *Howell*.

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. Applicant submits that based on the foregoing, claims 1-20 are allowable over the cited prior art. Applicant further requests that a timely Notice of Allowance be issued in this case. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance,

Applicant respectfully requests a telephone interview. Attorney for the Applicant may be reached at the number listed below.

Respectfully Submitted,

By 

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